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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,629	11/01/2001	Jason Quintana	10981981-4	3888

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EXAMINER

BROOKE, MICHAEL S

ART UNIT	PAPER NUMBER
	2853

DATE MAILED: 01/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/016,629	QUINTANA ET AL.
	Examiner Michael S. Brooke	Art Unit 2853

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 19 December 2003.
- 2a) This action is FINAL.
- 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,11,12 and 21-27 is/are pending in the application.
 - 4a) Of the above claim(s) 24-27 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,11,12 and 21-23 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 01 November 2001 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) Interview Summary (PTO-413) Paper No(s) _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 24-27 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The originally presented claims are directed to a method and a product produced by the method. The newly presented claims are directed to an apparatus for practicing the method.

Distinctness between a method and the apparatus for its practice is shown if the method can be practiced by a materially different apparatus. In this case, the method does not require an apparatus that retracts the medium into apparatus. Rather, the method can be practiced by an apparatus that applies the backing outside of the printer.

Similarly, the distinctness between the product made and the apparatus for producing the product is shown if the product can be produced by a materially different apparatus. In this case, the product could be produced by an apparatus that does require the medium to be backed into the apparatus.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 24-27 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 11, 12 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Brault et al. (5, 837,375).

Brault teaches an ink jet recording element and a process for forming the element. The element comprises (Fig. 3B) an opaque backing (22), a transparent (therefore translucent) image receiving layer (16) and a transparent medium (14). Looking at Figs. 1 and 2, it can be seen that an image (18) is printed onto the ink receiving layer and then the backing (22) is applied over the printed image, in order to bond to the ink receiving layer (col. 8:5-8).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 21 and 23 rejected under 35 U.S.C. 103(a) as being unpatentable over Brault et al. (5,837,375) in view of Aylward et al. (5,998,119).

Brault et al. teaches the claimed invention with the exception of the ink receiving layer is a sol-gel containing titania particles.

Brault et al teaches that the ink receiving layer may contain a variety of different particulate materials (col. 6:59-67 and col. 7:1-10). Aylward et al. teaches an ink jet imaging element having a porous ink receiver. The ink receiver may contain particulate materials such as, silica, calcium carbonate clay, talc, zeolites, titanium dioxide, sol-gels and mixtures thereof (col. 4:36-47). Thus, all of these materials are shown to be art recognized equivalents for their use in an ink receiving layer. Because these materials were art recognized equivalents at the time the invention was made, one of ordinary skill in the ink jet art would have found it obvious to have substituted a sol-gel mixed with titanium dioxide for any of the particulate materials disclosed in Brault et al, in order to aid in enhancing the smoothness of the ink receptive layer.

Response to Arguments

8. Applicant's arguments filed 12/19/03 have been fully considered but they are not persuasive.

Applicant's argument that the term "translucent" cannot reasonably be interpreted to mean "transparent," is not persuasive. As the enclosed dictionary definition shows, these terms are synonymous. Therefore, the claimed limitation is met.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael S. Brooke whose telephone number is 703-305-0262. The examiner can normally be reached on M-F 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on 703 308-4896. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 2853

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4900.



Michael S. Brooke
Examiner
Art Unit 2853

MSB
1/07/04